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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,322	10/27/2003	Gary T. Albright	00725.P1US	4872

28778 7590 03/21/2006

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EXAMINER

CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/695,322	Applicant(s) ALBRIGHT, GARY T.	
	Examiner Robert J. Canfield	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13 is/are rejected.
- 7) ☒ Claim(s) 6, 9, 10, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/20/04</u> | 6) <input type="checkbox"/> Other: _____ |

1. This is a first Office action on the merits for application serial number 10/695,322 filed 10/27/03. Claims 1-15 are pending.
2. The replacement drawings filed 04/15/04 are accepted.
3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
4. Claim 6 is objected to because of the following informalities: "said cavity" lacks antecedent basis. Note claim 6 depends from claim 1. The cavity is not introduced until claim 3. Appropriate correction is required.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
6. Claims 1, 7, 8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,276,107 to Elmendorf.

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Elmendorf provides a roofing element or "shake" having at least one fastener channel 4 extending between the upper and lower surface, which has a strip 6 inserted therein and nails driven there through (Figure 6). The channel 4 is provided with a dovetail shape, which provides pointed barbs or lips on each edge thereof.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,052,961 to Gibbs.

Gibbs provides roofing panels or "shakes" 322/324 having a slot or "fastening channel" 328 therein. The slot 328 extends not only between but also from the top surface to the bottom surface. The slot is as capable of performing the intended use "adapted to for installation of a strip..." as the channel of claim 1.

Note that the strip is not a positively recited element of the claims.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,052,961 to Gibbs in view of U.S. Patent 5,630,305 to Hlasnicek.

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Gibbs provides each of the elements of the claims as noted above except for insulative cavities on the lower surface side of the shake and a textured finish on the upper surface to simulate a wood shake.

Hlasnicek teaches at the time of the invention it was known to provide the lower surface of a roofing panel or shake with cavities 29 to improve insulating characteristics (column 4, line 39) and to provide the exposed upper surface 25 with a wood grain 23 substantially duplicate to that of a wooden shake (Column 4, line 33).

It would have been obvious at the time of the invention to one having ordinary skill in the art that the panels 322/324 of Gibbs could have been provided with both an upper wood grain shake appearance as taught by Hlasnicek at 23 and lower insulating cavities as taught by Hlasnicek at 29. It would have been obvious to provide a roofing panel that simulated a wooden shake and had increased insulating properties. Further, Gibbs recites at column 5, lines 37+, the invention may be practiced with any form of shingles or panels. This would suggest to one of ordinary skill in the art that the panel 322/324 of Gibbs could be modified as taught by Hlasnicek.

10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,052,961 to Gibbs as modified by U.S. Patent 5,630,305 to Hlasnicek above, further in view of U.S. Patent 3,899,855 to Gadsby.

Gibbs as modified by Hlasnicek provides each of the elements of the claims as noted above except that the cavities 29 are filled with insulative material, more particularly, polystyrene.

Gadsby teaches that at the time of the invention it was known to fill cavities on the lower or back side of a roofing element with an insulating foam 6 to increase its insulating properties.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the cavities 29 of Hlasnicek could have been filled with foam as taught by Gadsby at 6. It would have been obvious to increase the insulating properties. The examiner takes Official Notice that polystyrene is a substantially equivalent insulating foam to the polyurethane taught by Gadsby and that polystyrene would have been an obvious material choice for the foam of Gadsby for its inherent material properties and equivalency to polyurethane as an insulating foam material.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,052,961 to Gibbs in view of U.S. Patent 5,295,339 to Manner.

Gibbs provides each of the elements of the claims as noted above except for slots on the lower surface side of the shake to channel water and provide ventilation.

Manner teaches at the time of the invention it was known to provide the lower surface of a roofing panel or shake with grooves or "slots" 25 to improve ventilation and insulation.

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It would have been obvious at the time of the invention to one having ordinary skill in the art that the panels 322/324 of Gibbs could have been provided with lower surface grooves cavities as taught by Manner at 25. It would have been obvious to provide a roofing panel with increased ventilation and insulating properties. Further, Gibbs recites at column 5, lines 37+, the invention may be practiced with any form of shingles or panels. This would suggest to one of ordinary skill in the art that the panel 322/324 of Gibbs could be modified as taught by Manner.

12. Claims 9, 10, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

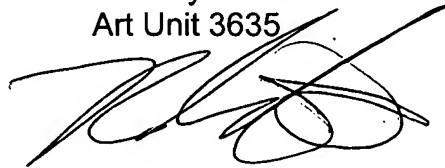
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield
Primary Examiner
Art Unit 3635

A handwritten signature in black ink, appearing to read 'R. Canfield', is written over the printed name and title.

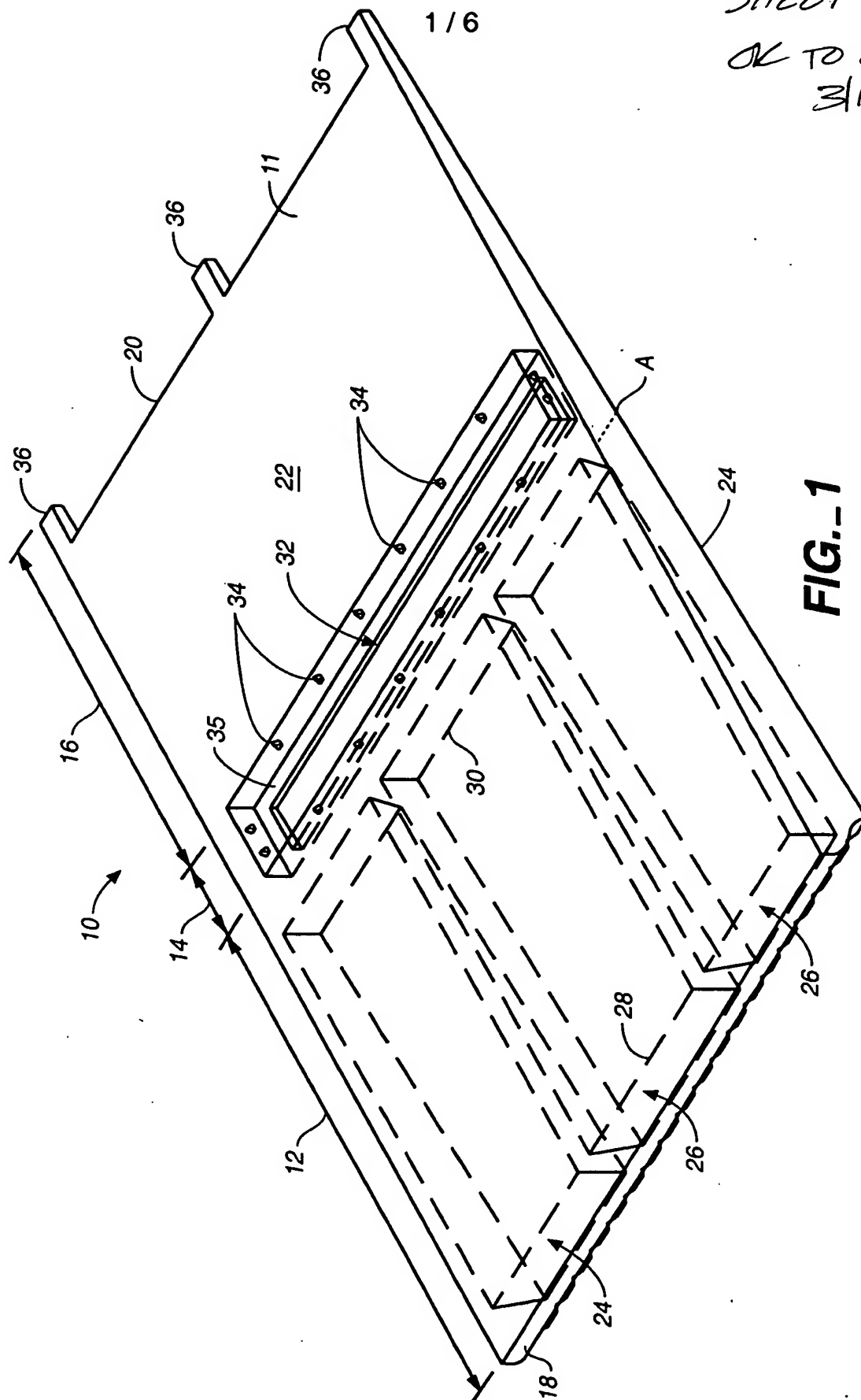
03/17/06



00725.P1US

10/695322
REPLACEMENT
SITEET

OK TO ENTER (12)
3/16/06



+



FIG.-2

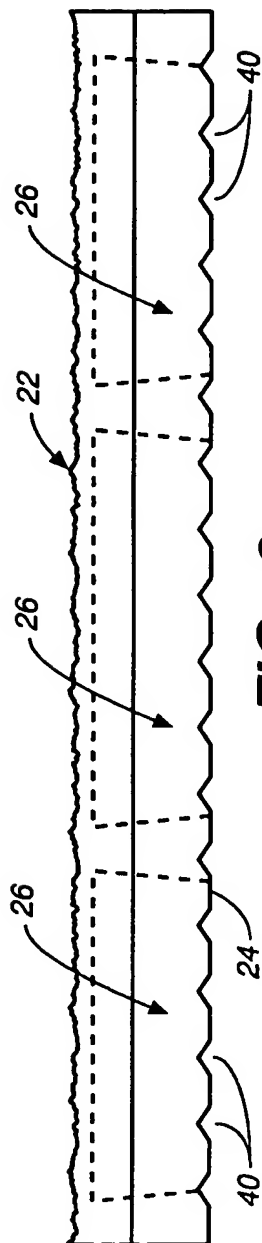
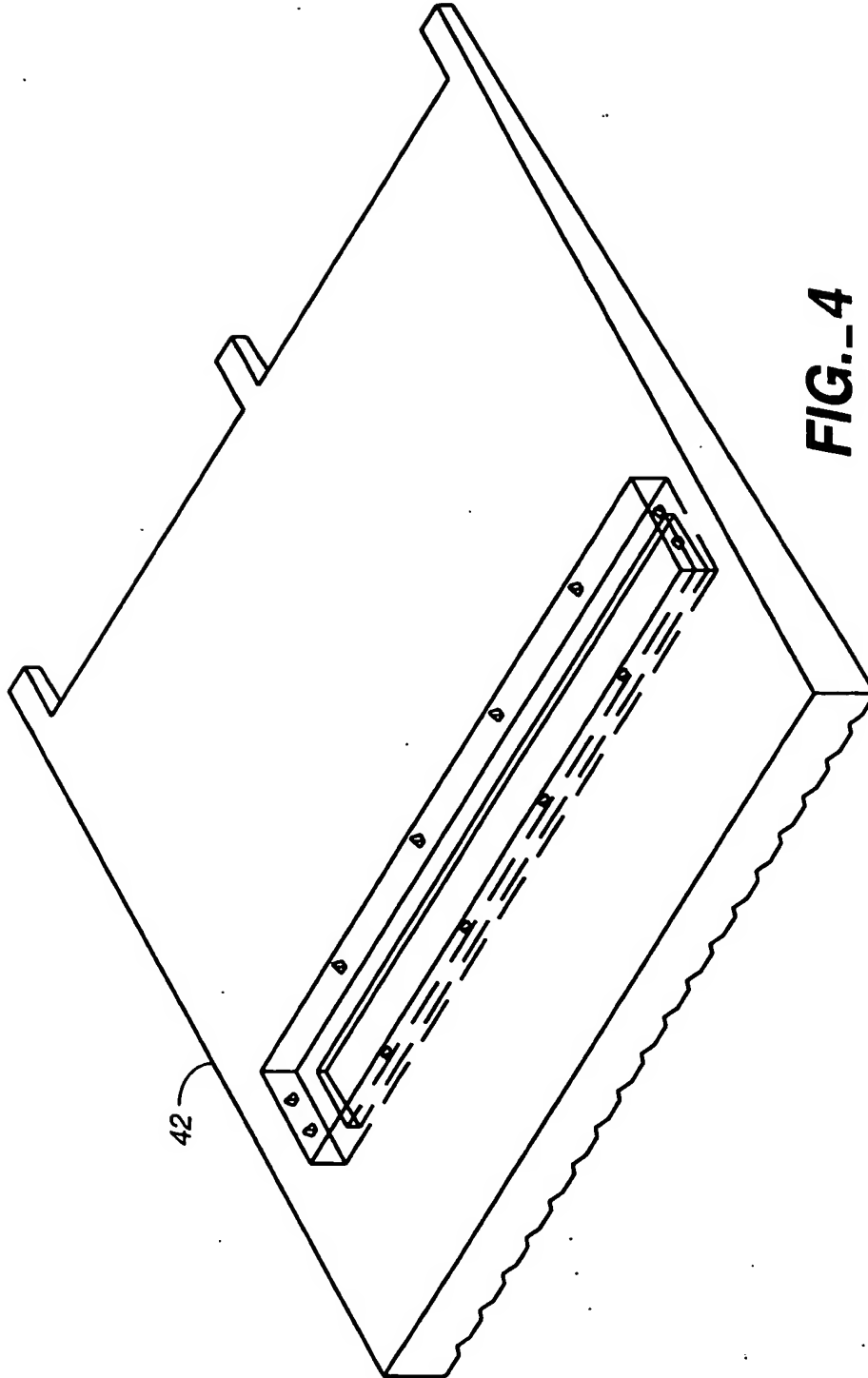


FIG. 3

10/695322
Replacement
Sheet
OK TO ENTER (12)
3/16/06



10/695 322
Replacement Sheet
OK TO ENTER
(P) 3/16/06

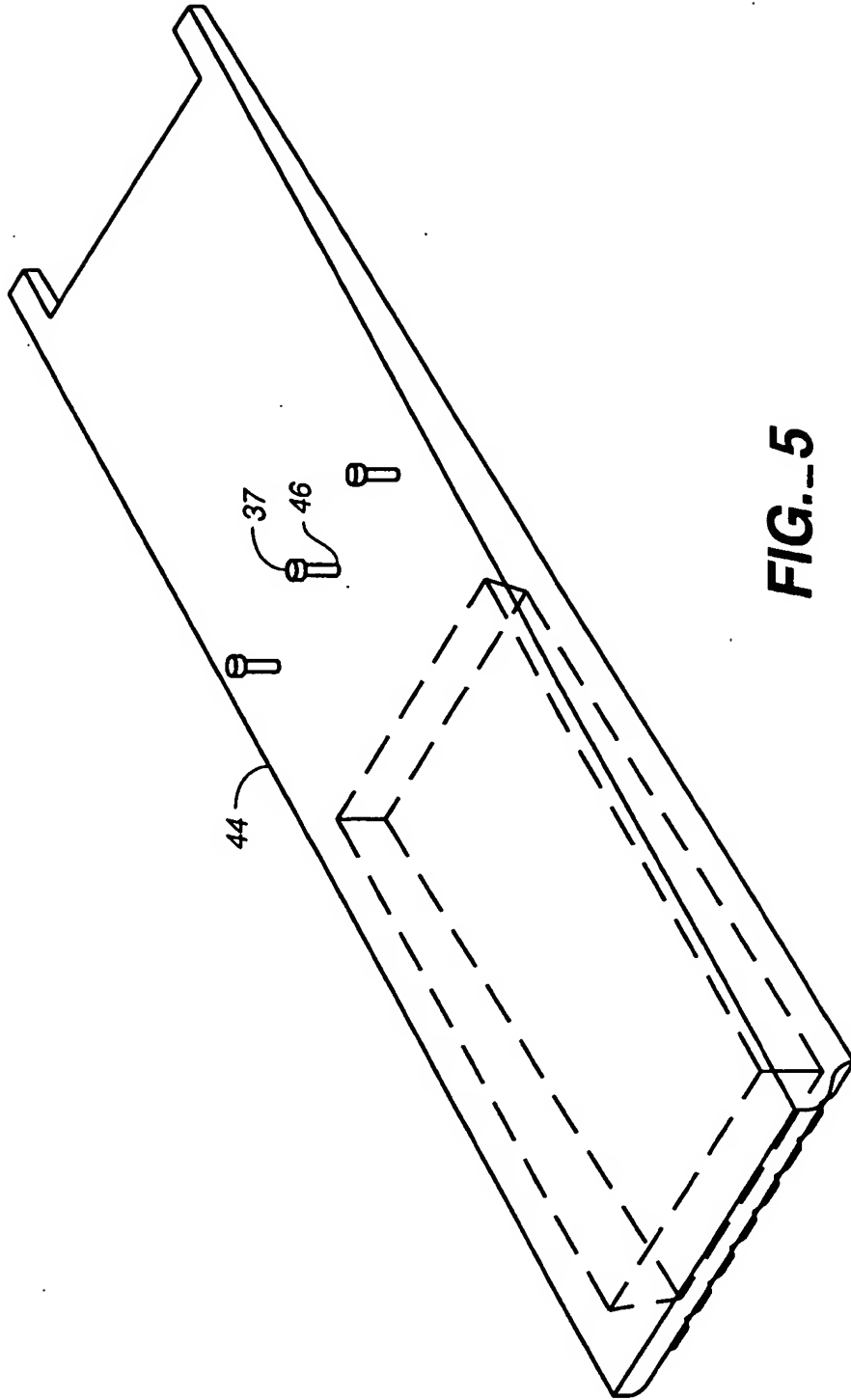
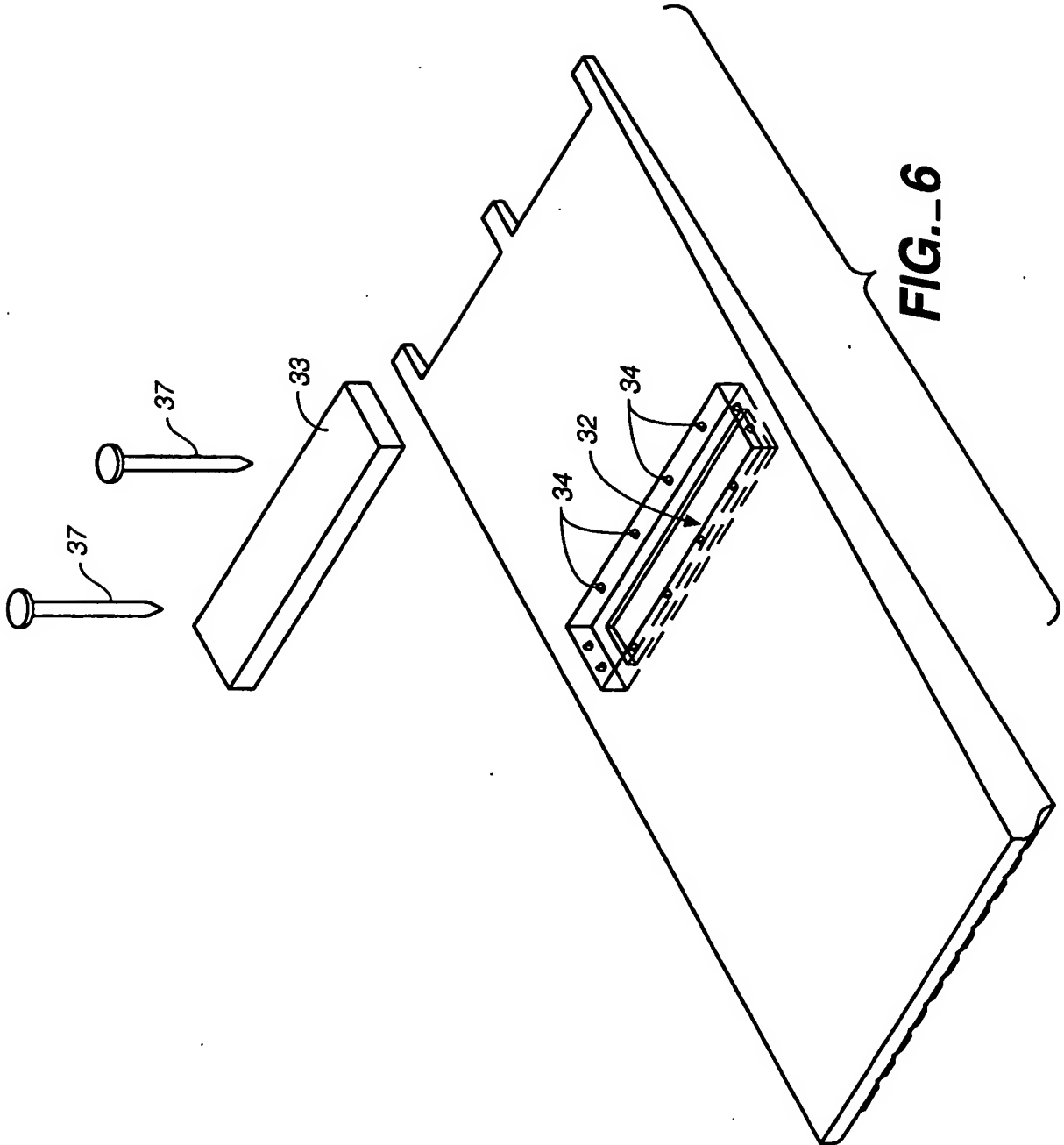


FIG. 5

10/695322
Replacement Sheet
OK to enter
(12C) 3/16/06



OK TO
COPY
3/16/06

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10/695322
Replacement Sheet.

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FIG. 7

